

## REMARKS

Claims 1, 2, 4, 5, 14-17, and 19-21 are pending. No claims are amended herein. As a result, claims 1, 2, 4, 5, 14-17, and 19-21 remain pending for examination.

### *Interview Summary*

Applicant thanks Examiner Vogel for granting an in-person interview with Applicant's representative Brenda Jarrell on June 22, 2010. During the interview, Examiner Vogel and Applicant's representative discussed the Harney reference and its relevance to the present case. In particular, Applicant pointed out the following timeline to the Examiner:

June 16, 1997	Harney priority document filed
September 20, 1997	Harney sole inventor passed away
December 24, 1998	Harney cited reference filed, significantly updated with respect to Harney priority document
July 21, 2000	Present priority document filed
July 20, 2001	Present application filed

Applicant therefore pointed out that updates to the Harney reference were apparently done *after* the sole name inventor had passed away. Those updates were also done by a law firm and lawyer who were simultaneously representing the present Applicant and inventor with respect to various patent applications related to the present case.

Applicant and the Examiner agreed that it would be helpful to the Examiner if the Applicant could provide a redlined document showing the changes made to the Harney reference when it was updated from the priority document, and to point out how those updates relate to the present case. Applicant has therefore enclosed such a redlined document.

As can be seen from the enclosed redline document, the concept of assembling functionality from fragments not present in the Harney priority application, but rather was added when the CIP was filed. In the Interview, the Examiner agreed that this concept was distinct from the idea of assembling vectors of complete functional pieces, as was described in the Harney parent application.

It is of course apparent that the sole named inventor on the Harney CIP could not have invented the new concept of assembling functionality from fragments after he passed away. Given that Harney passed away within three months of the filing of the parent patent application, it is very unlikely that in fact the idea was his. It is therefore Applicant's position that this concept was most likely added to the application by the practitioners who updated the Harney filing when preparing the CIP. Given that these same practitioners also prepared various applications for the present inventor (e.g., U.S. Pat. Appl. Nos. 08/119,512 and 08/488,015), and in fact were working with the present inventor on Office Action responses in some of those cases during the time period between the filing of the Harney parent application and the Harney CIP, it is clear that those practitioners were exposed to the present inventor's ideas and insights.

In light of these facts, Applicant respectfully submitted that the only disclosure in the cited Harney reference that is relevant to the present claims was not invented "by another" and therefore is not available as prior art. Examiner requested that Applicant submit the above-mentioned redlined document and other relevant materials in order to permit her fulsome consideration of the situation; the present Response includes such materials. Applicant thanks the Examiner for her careful consideration of the case.

#### ***Claim Rejections under 35 U.S.C. § 102***

Claims 1, 2, 4, 5, 12, 14-21 stand rejected under 35 U.S.C. 102(c) as allegedly anticipated by Harney et al. (U.S. Patent 6,495, 318). It was pointed out in the Office Action that certain sections of the cited reference disclosed the subject matter of the instantly claimed invention. More specifically, the Examiner identified the following portions of the cited reference to be

allegedly anticipating disclosure: Figure 1; col.1, lines 58 – col.2, line 15; col.17, lines 15-23; col. 2, lines 33-41; col. 56, lines 18-23; col. 7, lines 11-26; and col. 17, lines 61-65.

As discussed with the Examiner during the in-person interview, and further documented herein, Applicant respectfully submits that this material was not invented “by another” and the rejection should be removed.

First of all, as discussed with the Examiner during the interview, Applicant submits that the relevant subject matter, which relates to the idea of assembling functionality from fragments, was only added in the Harney CIP (U.S. Patent 6,495, 318) and was not in the Harney parent application (U.S. Patent 6,277,632). Applicant submits a redline document (Exhibit A) showing the difference between the Harney parent and CIP application. As shown in Exhibit A, the portions identified by the Examiner in the Office Action as alleged anticipatory disclosure correspond almost exactly to the new matter added to the Harney CIP when it was filed on December 24, 1998. As is clear, the parent application of Harney et al. (U.S. Appl. No. 08/877,034, now issued as U.S. Patent 6,277,632, filed on June 16, 1997) did not contain any of the alleged anticipatory subject matter.

Secondly, Applicant submits that Harney could not have invented the alleged anticipatory subject matter (which was not in the parent case and only added in the CIP) because the sole inventor in the Harney CIP, Dr. Peter D. Harney, passed away on September 20, 1997, within three months after the parent application was filed and 15 months before the filing of CIP. A copy of obituary regarding Dr. Harney’s death is attached as Exhibit B. Given that the new subject matter was added in the CIP 15 months after his death, it is highly unlikely that these ideas were Harney’s. It is much more likely that they were added by the practitioners who drafted the CIP.

Applicant wishes to point out that the attorney responsible for the CIP, Matthew Vincent, was the same attorney who drafted and prosecuted certain inventions of the present inventor Dr. Kevin Jarrell and in fact was working with the present inventor on those inventions at the time when the Harney CIP was being prepared and filed. As supporting evidence, Applicant submits Exhibit C containing PAIR records (transaction history) showing prosecution matters handled by

Matthew Vincent for one of Dr. Kevin Jarrell's inventions during the time period when the Harney CIP was prepared and filed (e.g., from December 1997-December 1998). Thus, Applicant submits that the attorney who drafted the Harney CIP worked closely with the present inventor Dr. Kevin Jarrell during the period when the Harney CIP was prepared. It is therefore likely that this attorney was exposed to Dr. Jarrell's ideas and insights relating to relevant technology.

Applicant also wishes to bring to the Examiner's attention that the same attorney shows the same pattern of behavior across clients. Recently, Cold Spring Harbor (CSH) filed a complaint against Matthew Vincent for allegedly "borrowing" certain description of subject matter from a third party patent application and adding it to a CSH patent application he drafted, which led to rejection of the CSH application by the Examiner as being anticipated by the third party patent application from which the description was borrowed. Applicant submits herewith Exhibit D containing relevant sections of the CSH complaint for the Examiner's reference. The Examiner will also be aware that the Harney specifications (both the parent and the CIP) include large sections of text that are identical to earlier-filed applications of the present inventor, Dr. Jarrell. These earlier-filed applications were prepared by Matthew Vincent. Exhibit E encloses a comparison of the Harney CIP application with U.S. Pat. Appl. 08/488,015, filed June 7, 1995 (issued as U.S. Pat. 5,780,272 on July 14, 1998) and naming Kevin Jarrell as an inventor and Matthew Vincent as prosecuting attorney (the "Jarrell Specification"). In particular, Applicant directs the Examiner to pages 48-50 of Exhibit E. As can be seen, the highlighted sections are almost, if not entirely, identical to the corresponding sections of the Harney application. Thus, sections of the Harney application come directly from the Jarrell Specification. It is clear that the Harney "updates" by Mr. Vincent included extensive reference to Dr. Jarrell's work.

In view of the above, Applicant respectfully submits that the only disclosure in the Harney CIP that is relevant to the present claims cannot be considered to be invented "by

another”, and is not available as prior art under 102(e). Accordingly, Applicant respectfully requests that the rejection made under this section be reconsidered and withdrawn.

### **CONCLUSION**

In view of the foregoing, Applicant believes that all rejections have been overcome and the pending claims are in condition for allowance. If the Examiner believes a telephone call would be useful in expediting prosecution of this application, the undersigned invites the Examiner to call her at the number below. Early and favorable actions are respectfully solicited.

Respectfully submitted,

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Dated: September 7, 2010

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